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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,835	12/13/2000	Vernon Keith Boland	8598	5833

26890 7590 09/17/2008

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EXAMINER	
BORISSOV, IGOR N	
ART UNIT	PAPER NUMBER
3628	

MAIL DATE	DELIVERY MODE
09/17/2008	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VERNON KEITH BOLAND, KATHY DEAN,
RONALD A. RUSH JR., ROBERT N. JOSEPHSON, II
and DENNIS A. PARKER

Appeal 2008-2634
Application 09/735,835
Technology Center 3600

Decided: September 16, 2008

Before: LINDA E. HORNER, ANTON W. FETTING and
STEVEN D.A. McCARTHY, *Administrative Patent Judges*.

McCARTHY, *Administrative Patent Judge*.

REMAND ORDER

The Appellants appeal under 35 U.S.C. § 134 (2002) from the final rejection of claims 1-5, 7-10, 13, 15-18, and 20-24. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

The claims on appeal relate to a system and method for establishing the context of a consumer/business interaction. (Spec. 3, ll. 7-9). Claims 1-5, 7-10, 13, 15-18 and 20-24 are rejected as being anticipated or unpatentable over Gardenswartz (Patent US 6,298,330 B1, issued 2 Oct. 2001). The threshold issue before us is the statutory ground for this rejection. Based on the facts and analysis set out below, we REMAND this appeal to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (2007) for clarification of the statutory basis for the rejection.

BACKGROUND

Both the Final Office Action mailed May 19, 2005 ["Final Rejection"] and the Examiner's Answer mailed July 5, 2006 reject claims 1-5, 7-13 and 15-24, and those papers cite Gardenswartz as evidence of unpatentability. (Final Rejection at 9; Ans. 3.) Similarly, the Supplemental Examiner's Answer mailed October 1, 2007 rejects claims 1-5, 7-10, 13, 15-18 and 20-24, and cites Gardenswartz as evidence of unpatentability (Supp. Ans. 1).[1] The Final Rejection, Examiner's Answer, and Supplemental Examiner's Answer open the statement of the rejection with the heading: "Claim Rejections – 35 USC § 103." Each follows this heading with a quotation of the language of 35 U.S.C. § 103(a) (2002). (*Id.*) The Examiner finds that "Gardenswartz does not specifically teach that providing said interactive information which is relevant to the interaction with the registered customer includes providing a *context* for the communication received from the

[1] The Supplemental Examiner's Answer was filed in response to an Order mailed May 14, 2007 requiring clarification regarding which claims were subject to the rejection from which that Appellant appeals.

customer." (Final Rejection 10; Ans. 4; Supp. Ans. 2 [emphasis in originals].) The Examiner concludes that:

> it would have been obvious to one having ordinary skill in the art [at] the time the invention was made to modify Gardenswartz to include that said providing interactive information which is relevant to the interaction with the customer includes providing a *context* for the communication received from the customer, because without indication in the specification the advantages of using the term "context" over the prior art, it appears that said term "context" is [an] obvious variation of said interactive information associated with a particular purchase history classification.

(Final Rejection 10; Ans. 4.; Supp. Ans. 2)

On the other hand, both the Final Rejection and the Examiner's Answer follow the quotation of § 103(a) with the statement: "Claims 1-5, 7-13 and 15-24 are rejected under 35 U.S.C. 102(e) as being unpatentable over Gardenswartz et al. (6,298,330)." (*Id.*)[2] Similarly, the Examiner's Supplemental Answer follows the quotation of § 103(a) with the statement: "Claims 1-5, 7-10, 13, 15-18 and 20-24 are rejected under 35 U.S.C. 102(e) as being unpatentable over Gardenswartz et al. (6,298,330)" (Supp. Ans. 1).

The Brief on Appeal filed April 11, 2006 identifies the rejection at issue in this appeal as "[w]hether claims 1-5, 7-10, 13, 15-18 and 20-24 were properly rejected under 35 U.S.C. § 102(e) as being unpatentable over

[2] The Final Office Action mailed May 19, 2005 also included a rejection of claims 1-5 and 7-10 under 35 U.S.C. § 101 (2002) as not being within the technological arts. The Examiner withdrew this rejection in an Advisory Action mailed Oct. 12, 2005.

Gardenswartz et al. (U.S. Patent No. 6,298,330)." (App. Br. 6.) The Examiner's Answer states that the Appellants' statement of the grounds of rejection on appeal is correct. (Ans. 2.) Although the Brief on Appeal does not address the issue of whether it would have been obvious to modify Gardenswartz in accordance with the reasoning articulated by the Examiner, the Examiner's Answer does not point out this omission. (*See* Ans. 8-9.)

ANALYSIS

The Final Rejection, the Examiner's Answer, and the Supplemental Examiner's Answer are ambiguous as to the statutory basis for the rejection of claims 1-5, 7-10, 13, 15-18 and 20-24. Although the Examiner states that these claims are rejected under 35 U.S.C. § 102(e) (2002), the Examiner's reasoning in support of the rejection is inconsistent with a rejection under § 102(e) and consistent instead with a rejection under § 103(a). In particular, we note that "[t]o anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). The Examiner's concession that Gardenswartz does not disclose an element recited in each of the rejected claims calls into question whether the Examiner intended a rejection under § 102(e) or § 103(a).

In apparent reliance on the statement of the rejection in the Final Rejection and the Examiner's approval of the Appellants' statement of the "Grounds of Rejection to be Reviewed on Appeal", the Appellants did not address the issue of whether it would have been obvious to modify Gardenswartz so as to meet the limitations of the appealed claims. In light of this reliance, we believe that fairness requires us to remand this appeal so

that the Examiner can clarify the statutory basis for the rejection and so that the Appellants may respond in the event that the Examiner maintains the rejection of these claims on a basis other than § 102(e).

DECISION

Pursuant to § 41.50(a)(1), we REMAND this appeal to the Examiner and ORDER that:

1) if the Examiner chooses to maintain the rejection of claims 1-5, 7-10, 13, 15-18 and 20-24, the Examiner shall prepare a Supplemental Examiner's Answer which clarifies the statutory basis for the rejection of the appealed claims and provides an opportunity for the Appellants to respond; and

2) the Examiner perform such further action as may be appropriate.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REMANDED

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